REMARKS

Claims 8 and 16 were rejected under 35 U.S.C. §112, second paragraph as being allegedly indefinite. Specifically, the Office Action indicates that the claims are indefinite in view of the terms "p300" and "CBP," because there is no definition of these terms in the claim and insufficient guidance in the specification as to what proteins these acronyms refer. Applicants respectfully traverse the rejection and request reconsideration.

Applicants respectfully note that the proteins p300 and CBP were well known in the art by these acronyms by the time the present application was filed. Accordingly, the acronyms for these proteins would thus be clear to one possessing an ordinary level of skill in the art. For instance, as evidenced by the attached abstract by Chrivia *et al.* (1993, Nature, 365(6449): 855-59), the CBP protein has been known in the art since at least 1993 when it was discovered as a nuclear protein of 265K that binds to phosphorylated CREB. The protein was therefore designated CREB-binding protein, or CBP. Further, as shown by the attached abstract by Eckner *et al.* (1994, Genes Dev. 8(8): 869-84), the p300 protein has been known in the art since at least 1994 when it was discovered as an E1A-associated protein having the properties of a transcriptional adaptor. Later it was found that p300 and CRB are functional homologues that each mediate nuclear receptor activated gene transcription (see abstracts for Lundblad *et al.*, 1995, Nature 374(6517): 85-8, and Chakravarti *et al.*, 1996, Nature 383(6595): 22-3).

It is clear in view of the above cited references that p300 and CRB were proteins that were well known by these acronyms and that they had been well-characterized by the

time the subject application was filed. According to MPEP 1504.04(II), the claim language "must be analyzed - not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art." *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Thus, a claim may appear indefinite when read in a vacuum, but may be definite upon reviewing the application disclosure or prior art teachings. *Moore*, 439 F.2d at 1235 n.2, 169 USPQ at 238 n.2.

Applicants respectfully submit that the terms p300 and CRB would be clear to one of ordinary skill in the art in view of the state of the prior art as exemplified by the references discussed above. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

Claims 7, 8, and 15-16 were rejected under 35 U.S.C. §102(a) as being allegedly anticipated by either Pouponnot *et al.* or Janknecht *et al.* Applicants respectfully traverse the rejection.

The Examiner's attention is respectfully directed to the fact that the priority date of the present application is January 14, 1998, which is before the publication dates of both Pouponnot *et al.* (September 4, 1998) and Janknecht *et al.* (July 15, 1998). In order to satisfy the requirements of 37 CFR §1.55(a)(4), attached to this Reply is an English translation of the priority document, together with a statement that the translation of the certified copy is accurate.

As is clear from the English-language document, the priority document provides written descriptive support and enablement of the claimed invention. Thus the disclosure

of the priority document is in compliance with the requirements of 35 U.S.C. 112, first paragraph. The grant of the priority date is warranted for the claimed subject matter.

Seeing as priority to Japanese Patent Application 017818/1998 has been effectively claimed, and this priority application was filed prior to the Pouponnot *et al.* and Janknecht *et al.* references, withdrawal of the rejections under 35 U.S.C. §102(a) is respectfully requested.

This reply is fully responsive to the Office Action dated September 10, 2002. Therefore, a Notice of Allowance is next in order and is respectfully requested.

Except for issue fees payable under 37 CFR §1.18, the commissioner is hereby authorized by this paper to charge any additional fees during the pendency of this application including fees due under 37 CFR §1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 CFR §1.136(a)(3).

If the Examiner has any further questions relating to this Reply or to the application in general, he is respectfully requested to contact the undersigned by telephone so that allowance of the present application may be expedited.

Respectfully submitted
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Dated: **March 10, 2003**
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